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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
PHLY 25,356

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on 3/13/06

Signature 

Typed or printed name Gregory M. Howison

Application Number

9/614,937

Filed

07/11/2000

First Named Inventor

Jeffrey Jovan Philyaw

Art Unit

2144

Examiner

Marc D. Thompson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/06)

☒ attorney or agent of record. 30,646
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Gregory M. Howison

Typed or printed name

972-479-0462

Telephone number

3/13/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 38 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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MAR 13 2006

Patent / Docket No. PHL-25,356

Serial No.: 09/614,937
REASONS IN SUPPORT OF PRE-APPEAL
BRIEF REQUEST FOR REVIEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffry Jovan Philyaw

Serial No.: 09/614,937

Filed: July 11, 2000

Group: 2144

Examiner: Marc D. Thompson

For: LAUNCHING A WEB SITE USING A PASSIVE TRANSPONDER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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3/13/06

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(Name of Person Mailing Document)

(Signature)

3/13/06

(Date of Signature)

**REASONS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Please consider the following reasons in support of the concurrently filed Pre-Appeal Brief Request for Review.

In the final rejection mailed on September 12, 2005, claims 1-12, 16-30, and 33-35 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,978,773 to *Hudetz et al.* ("*Hudetz*") in view of U.S. Patent No. 6,297,727 to *Nelson* ("*Nelson*") and further in view of U.S. Patent No. 5,905,248 to *Russell et al.* ("*Russell*"). Claims 13-15, 31, and 32 were rejected under the combination of *Hudetz*, *Nelson*, and *Russell* and further in view of U.S. Patent No. 5,640,193 to *Wellner* ("*Wellner*"). Claims 1-4, 8-11, 16, 18-22, 24, 26, 28, 29, 33, and 35 were also rejected

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under 35 U.S.C. § 103(a) over U.S. Patent No. 6,446,871 to *Buckley* et al. ("*Buckley*") in view of U.S. Patent No. 5,903,225 to *Schmitt* et al. ("*Schmitt*"). It is respectfully submitted that these §103 rejections are clearly not proper and are without basis. More specifically, as discussed below, the §103 rejections have a clear legal deficiency, because there is no motivation or suggestion to combine the references and because not all claim limitations are taught as needed to establish a *prima facie* rejection.

In more detail, MPEP §2142 specifies that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

In regard to what an examiner must show in order to establish a *prima facie* case of obviousness, MPEP §2142 further explains that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In regard to what an examiner must do in order to meet the first criterion for a *prima facie* rejection, MPEP §2143.01 specifies that:

Obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Federal Circuit recently provided additional guidance on the requirement for establishing a combination by stating that "in making the assessment of differences between the prior art and the claimed subject matter, *Section 103* specifically requires consideration of the claimed invention 'as a whole.' Inventions typically are new combinations of existing principles or features.... The "as a whole" instruction in title 35 prevents evaluation of the invention part by part.... Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result-often the essence of invention. *Id.*" *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

In the present situation, as explained in more detail below, the Examiner proposes various combinations of references without a proper suggestion or motivation to make each proposed modification. This means that the first criterion for a prima facie rejection has not been met, which in turn means the Examiner has failed to carry the burden of establishing a prima facie rejection. In addition, certain claim limitations are not taught or suggested by the cited combinations, which means that the third criterion for a prima facie rejection has not been met and that the Examiner has failed to carry the burden of establishing a prima facie rejection for this independent reason.

I. No Suggestion or Motivation to Combine the References

- A. Applicant submits that there is clear error with respect to the Examiner's rejection

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of claims 1-12, 16-30, and 33-35 under 35 U.S.C. § 103(a) over the combination of *Hudetz*, *Nelson*, and *Russell*. As detailed at length on pages 8-17 of Applicant's Response (filed on February 20, 2006, in response to the Final Office Action dated September 12, 2005), the rejections of claims 1 and 19 are deficient because there is no motivation to combine the references. In fact, as detailed in the Response, the text cited by the Examiner not only fails to support the combination, but frequently teaches away from such a combination.

For example, as detailed in paragraph 11 of the Response, *Hudetz* describes three characteristics needed for a code (*Hudetz*, Col. 6, lines 28-67). However, the codes described in both *Nelson* (a transponder ID code) and *Russell* (an encoded URL) do not have the three characteristics required by *Hudetz*. Accordingly, not only can Applicant find no teaching or suggestion for the combination, but the teaching of *Hudetz* is contrary to that of *Nelson* and *Russell*. As detailed in paragraph 13 of the Response, the Examiner not only fails to provide a proper motivation or suggestion for the combination of *Hudetz* and *Nelson*, but takes text from *Hudetz* out of context. This violates the standard imposed by MPEP § 2141.02(VI) that a prior art reference must be considered in its entirety. As detailed in paragraph 17 of the Response, the combination of *Hudetz* and *Russell* is not supported because *Hudetz* teaches away from the publication of a "mnemonic address or verbal description of a network location ... along with the location's numeric address in bar code format," while *Russell* is specifically directed to a "System and method for carrying out information-related transactions using web documents embodying transaction enabling applets automatically launched and executed in response to reading URL-encoded symbols pointing thereto."

B. Applicant submits that there is clear error with respect to the Examiner's rejection of claims 1-4, 8-11, 16, 18-22, 24, 26, 28, 29, 33, and 35 under 35 U.S.C. § 103(a) over the combination of *Buckley* and *Schmitt*. More specifically, as detailed at length on pages 20-25 of Applicant's Response (filed on February 20, 2006 in response to the Final Office Action dated September 12, 2005), the rejections of claims 1 and 19 are deficient because there is no motivation to combine the references. In fact, as detailed in the Response, the text cited by the Examiner not only fails to support the combination, but frequently teaches away from such a combination (see,

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e.g., paragraphs 44-46).

II. Even When Combined, the References Fails Teach or Suggest All Claim Limitations

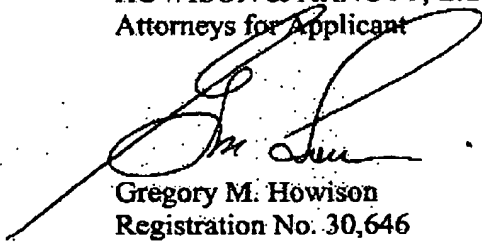
Applicant has detailed the failure of the references to teach all claim limitations in the previously filed responses. For example, in paragraph 42 of the Response filed on February 20, 2006, Applicant details why the *Buckley* reference fails to teach or suggest an "activation system" as required by independent claims 1 and 19.

Conclusion

Applicant submits that not only do the combined references fail to teach or suggest all claim limitations as required, but that the specific text cited by the Examiner from the various references fails to provide a suggestion or motivation for the various combinations because the text fails to illustrate "why" one skilled in the art would combine the references in the particular manner required. Instead, the text simply identifies particular components for each reference, allegedly combines them in a specific manner required by Applicant's claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Applicant respectfully requests that the rejections under § 103 be withdrawn.

It is respectfully submitted that all the claims in the application are in condition for allowance.

Respectfully submitted,
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